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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/725,004 | 12/02/2003 | Francesco Caeran | 38335/GM/Ip | 3158 |
| 513 | 7590 | 02/22/2006 | EXAMINER | |
| WENDEROTH, LIND & PONACK, L.L.P. | | | STASHICK, ANTHONY D | |
| 2033 K STREET N. W. | | | ART UNIT | |
| SUITE 800 | | | PAPER NUMBER | |
| WASHINGTON, DC 20006-1021 | | | 3728 | |

DATE MAILED: 02/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,004

Applicant(s)

CAERAN ET AL.

Examiner

Anthony Stashick

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The substitute specification and abstract filed August 17, 2005 have been reviewed and entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, 10-12 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Miralles et al. 6,050,004. Miralles et al. '004 discloses all the limitations of the claims including the following: as sole 3, 3B; an upper shell 7A, 7B monolithically associated with the sole (see Figures 4-5); the shell including a heel unit 7A and a separate toe unit 7B; adjusting means 31 for increasing an overall volume of the sports shoe by way of a forward movement of the toe unit with respect to the heel unit; the adjusting means 31 for increasing the overall volume of the sports shoe are adopted to produce an increase in width of the heel unit as a consequence of the forward movement of the toe unit (expansion); the toe unit pushes outwardly on the side of the heel unit (see Figures 6 and 7); the adjusting means for increasing the overall volume of the sports shoe comprises at least one pair of first slots 31, formed in a first lower surface of the toe unit; at least two protrusions 14 (Figure 3) that protrude upward from a second lower surface of the heel unit; the first slots being formed in the lower surface of the toe unit along direction that

Art Unit: 3728

mutually diverge toward a toe region and being adapted to accommodate the at least two protrusions therein for sliding motion (see Figure 4 and 5); the sports shoe being ski boot or skating boot (see Figure 1).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-8 and 13-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miralles et al. 6,050,004 as applied above in view of the European Patent to Aluxa 443293 (EP '293). Miralles et al. '004, as applied above, discloses all the limitations substantially as claimed except the slit located along the longitudinal central axis of the first lower surface of the toe unit. EP '293 teaches that the toe unit 16, 17 can have a slit (see Figure 2) that allows for the toe unit to expand with the width of the user's foot. This slit would allow for the region overlapping the toe and heel unit to extend with the width of the toe portion. The adjusting means for increasing the overall volume of the sports shoe comprises two flat wings (under portions of the upper of sections 16 and 17) formed by the slit on the first lower surface of the toe unit. The flat wings being connected proximate to the toe region (see Figure 2). The slit is substantially wedge-shaped (flat rectangular wedge) and runs from the rear edge of the first lower surface up to the toe region (see Figure 2). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a slit, such as that taught by EP '293, in the lower

Art Unit: 3728

surface of the toe unit of Miralles et al. '004, to allow for expansion in the width of the shoe with that of the user's feet. The slots of Miralles et al. '004 would be located in the wings if located in their current position.

6. Claim 9 and 18 are rejected under 35 U.S.C. 103(a) as being obvious over Miralles et al. 6,050,004 as applied to claims 1 and 11 above. Miralles et al. '004 teaches all the limitations of the claims except that limitations are reversed on the parts. Reversal of parts, i.e. putting the slots and protrusions on either the top or lower surface, would be well within the skill of one of ordinary skill in the art as it would merely require the parts to just change places. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the slots and protrusions on either the top or lower surface as the adjustment of the shoe would work equally well with these in either place.

Response to Arguments

7. Applicant's arguments filed August 17, 2005 have been fully considered but they are not persuasive. Applicant argues that the heel area of Miralles et al. is rigid and therefore the heel unit does not expand when the toe unit is moved forward. Miralles et al. teaches that the front portion of the toe unit 7B expands when the toe unit is moved forward. Furthermore, in Figures 6 and 7 of Miralles et al. is shown to have a rear section in the heel that is larger than the stepped-in section just in front of the heel. As this portion is moved forward, the material of the upper is removed from the heel portion and therefore, the heel portion would expand at least by the thickness of the upper portion 7B. Therefore, as the front portion is expanding, the rear portion expands. Furthermore, inasmuch as that which is shown by applicant, i.e. the heel

Art Unit: 3728

portion expansion, it appears that applicant's expansion is in the arch area, forward of the heel, as that shown in Miralles et al., and not in the heel.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

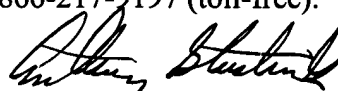
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS